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Michale Ortolano

Name

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Signature

November 22, 2005

Date of Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Masato Nogawa et al.
Serial No.: 09/982,663
Filed: October 17, 2001
For: Three-Side Trimmer
Examiner: Kenneth E. Peterson
Group Art Unit: 3724

REQUEST FOR CONTINUED EXAMINATION (RCE) MADE PURSUANT
TO 37 C.F.R. §1.114 AND SUBMISSION IN RESPONSE TO THE FINAL
OFFICE ACTION DATED JUNE 22, 2005

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

1. This Request For Continued Examination is made pursuant to 37 C.F.R. §1.114 in response to the Office Action dated June 22, 2005, and includes submission including new claims, arguments, concise statements of references not in the English language and a copy of the Japanese priority document.

2. Applicant previously purchased a two-month extension on September 20, 2005. If any extension of time fees are due, applicant authorizes the Director to charge any fees that may be

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required or credit any overpayment to Deposit Account Number 08-2442.

3. The current claim status is as follows:

- a) claims 1-8 and 15 are cancelled;
- b) claims 11-14 and 16-54 are withdrawn;
- c) claims 9-13 and 16 and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over pages 1-5 of the specification and figures 9 and 10 of the specification. The Examiner took Official Notice that it is well known to use height sensors to measure the height of incoming work, and cited United States Patent Number 4,635,542 to Sebelist et al. (hereinafter Sebelist et al.) in support; and

- d) claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable, with the Examiner taking Official Notice that it is old and well known to electro-mechanically count the items in a stack based on stack thickness, and cited to coin counters that can be used to count coins in a stack.

4. In the Office Action dated June 22, 2005, the Examiner required a photocopy of the priority document. Accordingly, attached hereto as Exhibit A is a copy of an Abstract from the Japanese Patent Office for Application Number 2000-317862, filed October 18, 2000 entitled Three-Way Cutter, and a copy of publication number 2002127077, which is the publication of the application for this patent application and includes drawings. It is pointed out that the publication is in Japanese.

Accordingly, applicant respectfully requests that all objections to the claim of priority and priority documents be withdrawn and that this application be accorded the claimed priority date.

5. The Examiner required concise explanations for three pieces of foreign art.

a) EP 0 485 542 is directed to a device for setting up a three side trimmer by adjustment of a feed section 10, a transfer section 12, a cutting section 14, and an ejector 16 by means of actuators associated with these elements. The device has motor operated actuators connected to a control computer 18 having a memory including a setting up sequence program, the purpose of which is for adjustment of cutting parameters, previously determined, and optimal positions can be intentionally approached with one or more machine cycle phases. There is an input device for inputting cutting parameters. Adjustment of the book width, format plate 74 to stack height and so on can be performed by cutting parameters previously input into the control computer 18. This is significantly different than the claimed three-side trimmer invention wherein the waiting position of the pressing plate to a height level can be adjusted in real time based on the height of the booklet bundle measured by measuring means while the chuck mechanism holds the booklet bundle. Thus, the claimed invention and this reference are significantly different from one another in adjustment of the position of members according to the height of the booklet bundle.

b) Applicant points out that on December 29, 2003, applicant filed an Information Disclosure Statement that included references first cited in a Search Report from the European Patent Office in the counterpart EPC patent application. All of the references listed in the Search Report were disclosed in previously filed Information Disclosure Statements, which included EP 0485 542, EP 0 641 631 and EP 0

887 157. Applicant now submits this entire Search Report, which is attached hereto as Exhibit B.

The Manual of Patent Examining Procedure (Section 609.04(a)(III)) provides that where references were cited by a foreign patent office in a counterpart foreign application, the requirement for an Information Disclosure Statement can be satisfied by filing an English language version of the Search Report. Applicant points out that the Search Report submitted as Exhibit B is in the English language and indicates the degree of relevance of these references.

Accordingly, applicant respectfully requests that all of the references disclosed in the Information Disclosure Statements be considered by the Examiner.

6. On the following pages are a complete Listing of the Claims that includes the Amendments to the Claims. Words underlined are being added, and words with a strikeout line through them are being deleted. The Listing of the Claims on the following pages replaces all prior versions of the claims.